

In re Patent Application of:
CHAPMAN ET AL.
Serial No. 09/596,629
Confirmation No. 4379
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REMARKS

Applicants would like to thank the Examiner for the thorough examination of the present application. Claims 62-68 and 70 are directed to a computer-readable medium, and have been amended to more clearly define such a computer-readable medium. The arguments supporting patentability of the claims are presented in detail below.

I. The Claims

The present invention, as recited in independent Claim 1, for example, is directed to a method for distributing an invention disclosure over an intranet. The method comprises accessing an invention disclosure template form over the intranet, and creating an invention disclosure using the invention disclosure template form. The invention disclosure is created by an inventor and includes information about an invention.

The method further comprises selecting an option in the invention disclosure template form to include an attachment with the invention disclosure. A file is attached to the invention disclosure without the use of a hyperlink. The file is created by the inventor separate from the invention disclosure and includes information about the invention that is not included in the invention disclosure.

The invention disclosure is submitted along with the attached file over the intranet to at least one evaluator via e-mail with a hyperlink to the invention disclosure. Evaluation comments on

In re Patent Application of:
CHAPMAN ET AL.
Serial No. 09/596,629
Confirmation No. 4379
Filing Date: June 19, 2000

the invention disclosure and the attached file are transmitted by the at least one evaluator via e-mail.

The present invention advantageously allows separately created files to be attached to the invention disclosure. As what typically happens with inventors, an inventor creates a file on their invention prior to creating and submitting an invention disclosure. The invention disclosure template form includes a provision to include these files as attachments. Without this provision, the additional information in the files would have to be retyped, or as a minimum, cut and pasted into the invention disclosure - both of which are labor intensive and time consuming.

Independent Claim 12 is similar to independent Claim 1 but further recites creating a profile of the invention disclosure, identifying first and second groups of users based upon the created profile, and transmitting first and second notification messages based to the respective first and second groups of users. Independent Claim 22 is similar to independent Claim 12, but further recites who the members are making up the first and second groups of users.

Independent Claim 31 is directed to an intranet for distributing an invention disclosure as recited in Claim 1. Independent Claim 42 is also directed to an intranet for distributing an invention disclosure as recited in Claim 12. Similarly, independent Claim 52 is also directed to an intranet for distributing an invention disclosure as recited in Claim 22.

In re Patent Application of:
CHAPMAN ET AL.
Serial No. 09/596,629
Confirmation No. 4379
Filing Date: June 19, 2000

Independent Claim 61 is directed to a computer readable medium as recited in Claim 1.

II. The Computer-Readable Medium Claims Are Directed To Statutory Subject Matter

The Examiner rejected Claims 62-68 and 70 directed to a computer-readable medium as being directed to non-statutory subject matter. As the Examiner is aware, descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions."

"Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data. Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se.

However, when functional descriptive material is recorded on a computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

The Applicants submit that all of the elements in independent Claim 62 directed to a computer-readable medium are structurally and functionally interrelated. Claim 62 is more

In re Patent Application of:
CHAPMAN ET AL.
Serial No. 09/596,629
Confirmation No. 4379
Filing Date: June 19, 2000

than a mere arrangement of data. For example, after the invention disclosure template is accessed from over the intranet, an invention disclosure is created using the invention disclosure template form. Consequently, these two claim elements are structurally and functionally interrelated. The inter-relationship continues with the rest of the claim elements.

As an example, computer-readable medium claims are provided in U.S. Patent Nos. 7,181,764 and 7,181,734. These claims are structurally and functionally interrelated as are the claims in the present case. Accordingly, it is submitted that Claims 62-68 and 70 are directed statutory subject matter.

III. The Claims Are Patentable

The Examiner rejected independent Claims 1, 12, 22, 31, 42, 52 and 61 over the Hager et al. patent in view of the Kuzma patent.

Referring now to the Hager et al. patent, an automation of procedures in a local area network (LAN) environment is disclosed. The procedures are automated in a data processing system with regard to the invention disclosures stored therein. As correctly noted by the Examiner, Hager et al. fails to disclose 1) an attachment for the invention disclosure that is created separate from the invention disclosure and is then attached thereto, and 2) submitting the invention disclosure to at least one evaluator with a hyperlink to the invention disclosure.

The Examiner takes Official Notice that it is well

In re Patent Application of:

CHAPMAN ET AL.

Serial No. 09/596,629

Confirmation No. 4379

Filing Date: June 19, 2000

known in the art at the time of the invention to send a hyperlink to a document instead of an entire document. The Examiner thus takes the position that it would have been obvious to combine the teaching of Hager et al. with the idea of sending a hyperlink instead of an entire document.

In addition, the Examiner cited the Kuzma patent as disclosing an attachment being included with a document, with the attachment having been created separately from the document. The Examiner thus takes the position that it would have been obvious to combine the teachings of Hager et al. with the teachings of Kuzma regarding creating an attachment separately from a document.

The present invention provides options to the inventor when creating an invention disclosure. In particular, the present invention allows a file describing the invention to be attached to the invention disclosure without the use of a hyperlink. The file is created separate from the invention disclosure and includes information about the invention that is not included in the invention disclosure. By attaching the file without the use of a hyperlink, the additional information about the invention remains "fixed" to the invention disclosure (page 15, line 6 in the Applicant's specification). As a result of the inventor being able to easily add information about the invention to the invention disclosure, the evaluators are more likely to provide an accurate evaluation of the invention.

The Examiner's response to this argument is that Hager et al. was published in the early 1990's and used technology

In re Patent Application of:

CHAPMAN ET AL.

Serial No. **09/596,629**

Confirmation No. **4379**

Filing Date: **June 19, 2000**

available at the time, and that the Applicants' invention is different from Hager et al. in that it claims the same process using the state of the art at the time of the Applicant's invention. The Examiner is unclear how the use of the state of the art technology is novel and not obvious. The Examiner further stated that the Applicants were to more clearly define how an attachment is submitted with an invention disclosure, and that this process would be more than merely attaching a Word document or PowerPoint presentation to an e-mail as argued by the Applicants.

The Applicants disagree with the Examiner that Hager et al. is the same process but uses different technology available at the time. One distinction between the claimed invention and Hager et al. is that the claimed invention provides options to the inventor when creating an invention disclosure, wherein a file describing the invention can be attached to the invention disclosure without the use of a hyperlink.

As the Examiner is aware, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim features. The Applicants submit that Hager et al. fails on all three of these accounts - which has nothing to do with the available technology available at the time.

In re Patent Application of:
CHAPMAN ET AL.
Serial No. **09/596,629**
Confirmation No. **4379**
Filing Date: **June 19, 2000**

At the time of the invention, Hager et al. discloses in a local area network (LAN) environment automated procedures in a data processing system with regard to the invention disclosures stored therein. Referring initially to FIG. 2, a high level flow chart illustrating the creation of an invention disclosure document is provided. Reference is directed to column 4, lines 44-53 of Hager et al., which provides:

"As is illustrated, the process begins at block **48** and thereafter passes to block **50** which depicts the creation of an invention disclosure document. In the preferred embodiment, the user is prompted for personal information about each inventor, critical dates information about statutory bar dates, and information about the problem solved and the solution. Next, block **52** gives the user the opportunity to revise the invention disclosure document, if such revision is necessary." (Emphasis added).

As highlighted above, in the preferred embodiment of Hager et al., the user is prompted for information about the problem solved and the solution. This means that the information to be evaluated as part of the invention disclosure must be typed in by the user.

If the amount of information to be entered is rather large, then this becomes a labor intensive and time consuming task for the inventor. If the inventor becomes impatient and fails to provide a sufficient amount of information about his invention, then one or more of the evaluators may not properly

In re Patent Application of:

CHAPMAN ET AL.

Serial No. **09/596,629**

Confirmation No. **4379**

Filing Date: **June 19, 2000**

understand or appreciate the invention - thus resulting in an unfavorable evaluation.

Hager et al. thus fails to teach or suggest providing options to the inventor when creating an invention disclosure, wherein a file describing the invention can be attached to the invention disclosure without the use of a hyperlink, as recited in the claimed invention. The Applicants submit that this is not a limitation of the technology available during the 1990s. Instead, Hager et al. simply fails to teach or suggest providing options to the inventor when creating an invention disclosure.

Applicants would also like to point out to the Examiner that an object of the Hager et al. patent is to automatically generate reports and to initiate additional procedures with regards to the invention disclosure document within a data processing system. In other words, Hager et al. provides sufficient detail on soliciting an evaluation vote from users automatically determined in response to identification of a functional area associated with the invention disclosure, as illustrated in FIGS. 3-7. However, Hager et al. simply fails to provide options to the inventor when creating an invention disclosure.

Referring now to the Kuzma patent, e-mail attachments are transmitted from a sender of a network to a recipient of the network. The attachments are stored in a storage device visible to the network and relatively local to the sender. Each attachment has a unique network address associated therewith. The

In re Patent Application of:

CHAPMAN ET AL.

Serial No. **09/596,629**

Confirmation No. **4379**

Filing Date: **June 19, 2000**

sender requests an e-mail option from the recipient, which provides a configurable e-mail page to the sender in response to the request. An attachment reference comprising the network address of the attachment is supplied to the configurable e-mail page. Reference is directed to column 4, line 65 to column 5, line 6 of Kuzma, which provides:

"Referring now to FIG. 4, there is illustrated an e-mail message format **400** in accordance with a preferred embodiment of the present invention. In the e-mail message format **400** of the present invention, when a user such as **PC 210** of FIG. 2 wishes to send an attachment with an e-mail message to a user such as **PC 212**, the e-mail message **401** is transmitted along with a relatively small attachment reference **402**, instead of actually transmitting the entire attachment file along with e-mail message **401** ..."
(Emphasis added.)

As correctly noted by the Examiner, the attachment as disclosed in Kuzma is created separate from the document (i.e., an e-mail), and the attachment is included with the document. The Examiner has taken the position that it would have been obvious to combine the teachings of Hager et al. with the teachings of Kuzma regarding creating an attachment separately from a document.

The Applicants respectfully submit that even if the references were combined as suggested by the Examiner, the claimed invention is still not produced. Kuzma discloses the use

In re Patent Application of:
CHAPMAN ET AL.
Serial No. 09/596,629
Confirmation No. 4379
Filing Date: June 19, 2000

of an attachment reference being supplied with the document instead of supplying the contents of the attachment. The attachment reference is essentially a hyperlink to the attachment.

In sharp contrast, the present invention has been amended to recite that the file is attached to the invention disclosure without the use of a hyperlink. When a file in the present invention is attached to the invention disclosure, it is "fixed" thereto, i.e., the contents of the file are sent along with the invention disclosure itself. Consequently, since Kuzma discloses that a hyperlink is used to attach a file to an e-mail, there is simply no motivation to selectively combine the references as suggested by the Examiner.

It thus appears that the Examiner is using impermissible hindsight reconstruction to modify the Hager et al. patent in view of the Kuzma patent in an attempt to produce the claimed invention. The prior art references, individually or in combination, do not teach or suggest

1) selecting an option in an invention disclosure template form to include an attachment with the invention disclosure, and 2) attaching a file to the invention disclosure without the use of a hyperlink, wherein the file is created by the inventor separate from the invention disclosure and includes information about the invention that is not included in the invention disclosure.

Accordingly, it is submitted that independent Claim 1 is patentable over Hager et al. in view of Kuzma. Independent Claims 12, 22, 31, 42, 52 and 61 are similar to amended

In re Patent Application of:

CHAPMAN ET AL.

Serial No. **09/596,629**

Confirmation No. **4379**

Filing Date: **June 19, 2000**


independent Claim 1. Therefore, it is submitted that these claims are also patentable over Hager et al. in view of Kuzma. In view of the patentability of independent Claims 1, 12, 22, 31, 42, 52 and 61, it is submitted that their dependent claims, which recite yet further distinguishing features of the invention, are also patentable. These dependent claims require no further discussion herein.

IV. CONCLUSION

In view of the amendments to the claims and the arguments provided herein, it is submitted that all the claims are patentable. Accordingly, a Notice of Allowance is requested in due course. Should any minor informalities need to be addressed, the Examiner is encouraged to contact the undersigned attorney at the telephone number listed below.

In re Patent Application of:
CHAPMAN ET AL.
Serial No. 09/596,629
Confirmation No. 4379
Filing Date: June 19, 2000

Respectfully submitted,



MICHAEL W. TAYLOR
Reg. No. 43,182
Allen, Dyer, Doppelt, Milbrath
& Gilchrist, P.A.
255 S. Orange Avenue, Suite 1401
Post Office Box 3791
Orlando, Florida 32802
407-841-2330